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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,639	03/17/2006	Yoshitaka Tomigahara	2006_0369A	5260
513 7590 02/19/2009 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
SOLOLA, TAOFTQ A				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
02/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/572,639

**Applicant(s)**

TOMIGAHARA ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

1625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-49, 51, 53, 54, 56, 58, 59, 61, 63, 65, 67, 69, 71 and 73 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-3, 5-49, 51, 53, 54, 56, 58, 59, 61, 63, 65, 67, 69, 71 and 73.

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Claims 1-49, 51, 53-54, 56, 58-59, 61, 63, 65, 67, 69, 71, 73, are pending in this application.

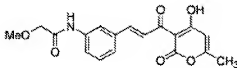
Claims 50, 52, 55, 57, 60, 62, 64, 66, 68, 70, 72, are canceled.

Only claim 4 is elected. Others are drawn to non-elected invention.

### ***Response to Restriction***

The election of group IV, claim 4, with traverse in the Paper filed 11/3/08 is hereby acknowledged. The traversal is on the basis that compounds of groups I-XIII, claims 1-25, were not restricted in the PCT application. This is not persuasive for reasons set forth in the last Office Action. Just because the International Search Authority chose not to invoke PCT Rules 13.1 and 13.2 is not a valid basis for the Office not to do so. Also, actions by the International Search Authority are not precedent or binding on this Office.

Applicant also selects this species



of claim 18,



wherein Xa is . Therefore, claim 4 is being examined in accordance with applicant's election.


The restriction is deemed proper and therefore, made FINAL.

### ***Status of Claims***


The compounds of claim 18 wherein ring A is phenyl or pyridyl and only substituent have been searched and found novel. Therefore, all the substituents of formula IV, except Xa, within the scope of claim 4, would not be subject to further restriction. The following are now in condition for allowance over prior arts of record.






In formula IV, X<sub>a</sub> is limited to , ring A is phenyl or pyridyl, Ka, La, Qa and Ya are as defined in claim 4. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claim 4, are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.




If  as representing X<sub>a</sub> is within the scope of formulae I-III, V-XIII, in claims

1-3, 5-25, and applicant restricts X<sub>a</sub> in the formulae and claims to , the restriction of groups I-III, V-XIII will be withdrawn.

### **Objection**

Claim 4 is objected for containing non-elected inventions and would be in position for



allowance if X<sub>a</sub> is limited to .

### **Telephone Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit

February 13, 2009